UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,203	06/15/2001	Leonard R. Bayer	HAR-003	8016

7590 08/10/2007

Kenneth J. LuKacher
South Winton Court
3136 Winton Road South, Suite 304
Rochester, NY 14623

EXAMINER	
WRIGHT, JAMES B	

ART UNIT	PAPER NUMBER
3693	

MAIL DATE	DELIVERY MODE
08/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/882,203	BAYER ET AL.	
	Examiner	Art Unit	
	J. Bradley Wright	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *10 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-29,40 and 42-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-29,40 and 42-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 25-29 and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helot, et al. (US Patent Application Publication No. 2002/0169675), in view of Cansler et al. (US Patent No. 6,725,257).

2. Regarding claim 25 and 42, Helot discloses a method for enabling product configuration market research comprising the steps of:

- market research software which when executed by computer systems enables each user of said computer systems to select the features of a hypothetical product configuration (Figures 6-11, and paragraphs 0056 – 0066);
- displaying via said market research software a total price value of the product at each of said computer systems in accordance with price values of said selected features separate from the operation of said network addressable site (item 605 in Figure 6, and paragraphs 0059 – 0065);

- updating said displayed total price value in accordance with changes in said selected features separate from the operation of said network addressable site (paragraph 0066);

- returning information via said network to said network addressable site having data representing at least said features selected when the user of each of said computer systems has completed the configuration of the product (item 640 in Figure 6, and paragraph 0041 and 0065); and

- determining at least one of new product, product configuration, pricing, or segmentation in accordance with said information (paragraph 0041).

The Examiner notes that Helot explicitly discloses the collection of statistical data regarding the users selections for the purposes of market research (paragraph 0041). Helot further discloses that several of the program modules may be located on the client instead of the server in order to place more processing load on the client (paragraph 0042). However, Helot does not explicitly disclose sending the market research software from a network addressable site, via a network, to one or more computer systems or that the user selects features of a product configuration not available via the software for purchase.

Cansler, in an analogous art, discloses a computationally efficient process for configuring a product over a computer network (column 1, lines 7-11) that includes the use of client-side processing to reduce the load on the server by shifting processing to the client. In particular, Cansler discloses that it is old and well-known in the art to transfer essentially all of the computation involved to the client machine instead of the

server by utilizing client-side processing in order to increase server efficiency by having the server do very little computation permitting the server to handle a very large number of client requests without becoming overwhelmed (see column 2, lines 3 – 12). Cansler discloses that such client-side processing can be acheived when the user uses the client machine to access the server, and the server downloads an independently executable module (for example, a Java applet, a browser plug-in or an Active X component) onto the client, so that the user can then use the executable module running on the client to configure the product (see column 2, lines 14 – 19). Cansler further discloses that the configuration system may not be coupled with an on-line ordering system (Figure 1 and column 4, lines 64-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Helot to download the program modules as an independently executable module (such as a Java applet) for configuring a product that may or may not be available via the software for purchase, in order to increase the server efficiency by utilizing client-side processing for configuring the products, as taught by Cansler.

3. Regarding claim 26 and 43, Helot further discloses that one or more of said features has a plurality of subfeatures for selection by each user of said computer systems, said total price value of the product is further in accordance with the price values of said selected subfeatures, and said data further represents said selected subfeatures for said selected features (Figures 6-11, and paragraphs 0056 – 0066).

The Examiner notes that Helot discloses features (i.e. processors) and subfeatures (i.e. processor speeds).

4. Regarding claim 27 and 44, Helot further discloses the step of measuring elapse time for each user of the computer systems to configure the product, and said information further comprises data representing said elapse time (paragraph 0041).

5. Regarding claim 28 and 45, Helot further discloses that said information further comprises data representing said selected features and any changes in the selection of said features by the user of each of said computer systems until said product configuration is completed (paragraph 0041).

6. Regarding claim 29, as discussed above, Cansler discloses that said information may be unassociated with any real purchase of the product (column 4, lines 64-67.

7. Claims 40 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helot, in view of Cansler, and in further view of Robb, et al. (US Patent No. 6,952,716).

The combination of Helot and Cansler meet the limitations of claims 25 and 42, as described above. However, neither Helot nor Cansler explicitly disclose sending a survey having questions to each of said computer systems from the network addressable site one of before, after, or before and after said step of sending market

research software, which enables the user of each of said computer systems to answer said questions and to send answers to said questions to the network addressable site.

Robb, in an analogous art, discloses a method for presenting data over a network based on network user choices and collecting real-time data related to said choices (see Abstract) that permits a user to take a survey in association with the configuration of various attributes of an on-line persona and saving the answers provided by the users (Figure 11 and column 11, lines 52-61) for the purpose of providing a less expensive, more efficient and more reliable means of capturing data on users, consumers and products (column 2, lines 38 - 45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Helot to include a survey before or after the configuration process in order to provide a less expensive, more efficient and more reliable means of capturing marketing data on users, consumers and products, as taught by Robb.

Response to Arguments

8. Applicant's arguments filed May 10, 2007 have been fully considered and are addressed below.

9. Applicant's arguments with regards to independent claims 25 and 42 have been fully considered but they are not persuasive.

10. Applicant argues that the cited prior art teaches systems for configuring orderable products, while the claimed invention is directed to hypothetical products. The Examiner fails to see a substantive difference or relation between the argued terminologies. It is the position of the Examiner that a product configured on a computer program is by definition a speculative or hypothetical product in that the configured product does not necessarily exist. The fact that it may be "orderable" is irrelevant. Indeed, as noted by Applicant in the response filed on May 10, 2007 on page 6, lines 4-7, "to state that a vehicle configured is not a hypothetical product would be antithetical to the express teachings of Cansler." This is particularly true in that the prior art explicitly teaches that user need not order the configured product, and may simply exit the program or configure another product.

11. Applicant further argues that the cited prior art is limited to real non-hypothetical and orderable products, and thus actually teach away from the claimed invention. The Examiner disagrees. Applicant appears to suggest that if a product is orderable, then the product must be real and non-hypothetical. As noted above, a product configured in the virtual world is by definition speculative or hypothetical, regardless of whether the configured product may ultimately be ordered. The configured product merely exists within the memory of a computer, despite the fact that an actual similar product may exist elsewhere. In fact, as discussed above, the prior art teaches that a user may configure multiple products and never order any of them. In such a scenario, each product configured was simply hypothetical to the user and never real. It is the

Examiner's position that the Applicant's reliance on the orderable nature of a configured product is misplaced, because the orderable nature of the product is unrelated to whether a product is hypothetical or not.

12. Further, Applicant fails to differentiate the structure or steps of the claimed invention from the cited prior art. In fact, Applicant does not allege that the prior art fails to teach a single step of the methods of claims 25 and 42. As such, the attempted differentiation between the configuration of orderable products and the configuration of hypothetical products is, at best, merely directed to the intended use of the claimed invention. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the present case, the prior art is clearly capable of configuring any product, regardless of whether the product is hypothetical, orderable or real.

13. Additionally, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

14. Applicant's arguments with regards to dependent claims 27 and 44 have been fully considered but they are not persuasive.

15. Applicant argues that the prior fails to teach measuring the elapsed time for each user of the system to configure a product. The Examiner disagrees. Helot teaches collecting statistical data related to the elapsed time a user spends in selecting options (i.e hovering over options) when configuring a product. In fact, it could be reasonably argued that Helot discloses collecting much more detailed statistical data regarding the elapsed time related to the configuration of a product.

16. Applicant's arguments with regards to dependent claims 28 and 45 have been fully considered but they are not persuasive.

17. Applicant argues that Helot fails to teach that its statistical data is described as having any changes in selection of features until product configuration is complete. The Examiner disagrees. Applicant asserts that the claim language describes that the "product configuration is completed" with respect to the data representing selected features and any changes, and suggests that Helot is interested only in those who do not complete the ordering process. However, configuring a product and ordering a product are two separate issues, as noted above. The fact that Helot tracks the number of users who do not complete the ordering process, does not preclude that Helot also tracks the statistical data related to the selections of the user in the configuration

process. As such, Helot teaches the collection of statistical data regarding the user selections until the product configuration is complete, regardless of whether the product is ultimately ordered.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bradley Wright whose telephone number is (571) 272-5872. The examiner can normally be reached on M - F 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jbw

7/27/07

JAMES A. KRAMER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600